

REMARKS

In light of the above-amendatory matter and remarks to follows, reconsideration and allowance of this application are respectfully requested.

Claim 8 has been amended to correct a typographical error. No new matter has been added.

Claims 1, 8, 14, 18 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (Phillips) (US Patent 6,615,189) in view of Ito et al. (Ito) (US Patent 6,039,250). Applicant respectfully traverses this rejection for the reasons discussed below.

The Examiner relies upon Phillips for disclosing various elements of applicant's claimed invention. In particular, the Examiner asserts (among other things) that Phillips discloses "giving the beneficiary an activated one of said money pick-up devices." (Office Action, page 4, line 5). This feature is recited in applicant's claims 1, 8 and 14, as well as in dependent claims 22 and 28. Contrary to the Examiner's assertion, Phillips does not disclose this feature. Rather, Phillips expressly teaches supplying a non-activated card to a recipient and, thereafter, the recipient must activate the card before using it. The process taught by Phillips is clearly described in that patent. Column 4, lines 1-6 provides that the card is delivered when the purchase card account is completed (i.e., when the purchaser buys the card) and the card is then delivered to either the purchaser or to a recipient. Then, the already delivered card must be activated. Column 4, lines 17-24 recites:

"Before the purchase card can be used to make purchases, it must be activated as shown in FIG. 2 at 230. Activation may be accomplished in any suitable manner. For example, the recipient 215 of the card may place

a telephone call to an activation center 240. Activation center 240 may act as a telemarketing vendor by verifying information about the recipient (i.e. name, address, telephone number, etc.) before the purchase card is activated. The activation center 240 may then transmit the data about the recipient to Data Service 200 to activate the purchase card for use.”

Therefore, Phillips does not disclose applicant’s claimed feature of supplying an activated card (i.e., money pick-up device or ATM card) to a beneficiary. Moreover, it would not have been obvious to modify the process described in Phillips to do so since activation after delivery is a clear requirement of the disclosed process in that patent. Phillips uses clear and definite terminology such as “must” to emphasize that it is critical in that disclosed process to require activation of the already delivered card. Still further, the feature of applicant’s claimed invention of providing an already activated card to a beneficiary must be considered in combination with the other steps (and elements) recited in applicant’s claims, with such providing of an activated card (i.e., money pick-up device) being carried out after various other steps have been carried out.

Turning now to the other reference relied upon by the Examiner, the Examiner relies upon Ito for allegedly disclosing other various features of applicant’s claimed invention (as recited in the independent claims) that are not disclosed in Phillips. In particular, the Examiner indicates that Phillips does not teach “providing a beneficiary with a unique device pick-up code, presenting the code to a distributor and activating the money pick-up device based on the pick-up code.” (Office Action, page 4, lines 9-11).

Before discussing Ito, however, it is noted that the Examiner refers not to the Ito patent, but rather to the Downing patent in the text of the discussion in the office action (Office Action page 4, lines 11, 15, 19, 20, 21 and 22). Downing was applied to reject the claims in the prior office action, but the Examiner explicitly withdrew his reliance upon Downing (in combination with Risafi), as set forth in paragraph 4 on page 2 of the present Office Action. Nevertheless, should the Examiner in a subsequent office action reassert Downing, before doing so, it is respectfully requested that the Examiner reconsider applicant's arguments set forth on pages 11-17 in the amendment filed November 20, 2003 (dated November 17, 2003). In particular, Downing expressly relates to "cardless withdrawal" by customers and non-customers and, thus, it is inappropriate to combine Downing with a reference that pertains to ATM cards and the like.

Turning now specifically to Ito, this patent is directed to the use of IC cards for storage and transfer of electronic money. The IC cards contain an arithmetic unit and nonvolatile memory (col. 3, lines 31-33). The patent clearly sets forth that the electronic money stored in the IC cards has the same value as cash (col. 3, lines 33-39). The IC cards are used with so-called information processing units (1, 2) that communicate with an electronic money server (3). The electronic money server may be installed in a bank. (col. 3, lines 17-62). The Ito patent describes the process of sending electronic money contained in an IC card from one party to an IC card held/owned by another party (col. 4, lines 4-14). To carry out the electronic transfer of electronic money, the "remitter" sets his/her IC card into an information processing unit (1) and remits a designated amount of electronic money to be transferred. (col. 4,

lines 22-27). The recipient (“recipient”) then must insert his/her IC card into an information processing unit (2) to accept the transfer (and authorize the transfer before the actual transfer is carried out) (col. 5, lines 21-56). The electronic money server (3) facilitates the transfer (col. 4, line 57 to col. 5, line 11). A security key (password), which may be a cipher key, is utilized to ensure proper security of the electronic money transfer (col. 4, lines 51-56; col. 5, lines 31-35).

The Combination of Phillips and Ito Would NOT Produce Applicant’s Claimed Invention

As discussed above, Phillips does not disclose various features of applicant’s claimed invention. The Examiner acknowledged that Phillips does not disclose providing a beneficiary with a unique device pick-up code, presenting the code to a distributor, and activating the money pick-up device based on the pick-up code.

Also, as discussed above, Phillips does not disclose supplying an activated card (money pick-up device or ATM card) to a beneficiary. Rather, Phillips discloses supplying a de-activated card.

It is submitted that Ito also does not disclose these features. Ito does not provide any sort of money pick-up device (or fund pickup number) to a beneficiary that is “presented” to a distributor that then results in activation of a device by the distributor. The only code or password disclosed in Ito is utilized as a security measure to carry out the electronic transfer of electronic money to the recipient’s IC card. In the reference, a code is not provided to a beneficiary that is then supplied to the distributor. There are no “distributors” in Ito. Even if an information processing unit (1 or 2) in Ito can be deemed to be a “distributor,” the recipient certainly does not

provide any pick-up code in order to obtain this device. Rather, the information processing unit receives the password (or cipher key) directly from the electronic money server 3. Furthermore, there is no activation of a device in Ito. Rather, money is transferred from one IC card to another. The IC cards are already activated. The change in the amount of money that is now stored on the recipient's IC card does not constitute activation of that IC card. Finally, Ito does not disclose supplying an activated card to a beneficiary (or recipient). Ito enables the transfer of electronic money and is not concerned with how devices are disseminated.

Finally, neither Phillips nor Ito discloses or suggests providing a device or card to a recipient after the recipient supplies a particular code to a distributor. Phillips sends the card to the recipient first (activation thereafter occurs). Ito does not concern itself with how the disclosed IC cards are distributed to recipients.

In view of the foregoing, it is submitted that the teachings of Phillips combined with the teachings of Ito does not produce applicant's claimed invention. The deficiencies of Phillips are not cured by Ito.

It Would NOT Be Obvious to Combine Phillips and Ito

Notwithstanding the above discussion, it is further submitted that it is improper to combine Phillips and Ito to reject applicant's claimed invention. While both references are concerned with the transfer of money from one party to another, the similarities end there. Phillips calls for purchasing a card that can be delivered to a recipient who then must activate the card before using it. The card is a typical type of debit card whereby the recipient can use it to make purchases. The card references

an account in which funds are stored. The card is not a device having stored therein electronic money that is equivalent to cash.

Ito pertains to the use of IC cards in which electronic money is stored therein. The IC cards do not reference an account, but rather, actual electronic money is stored in the IC card. Also, Ito does not provide for a customer transferring money to another person by "purchasing" a card that is delivered. Rather, both the sender and the recipient already must have IC cards. Phillips calls for activation of an already delivered card before it can be used. Ito is not concerned with activation at all. A password or cipher key is used solely to ensure secure transfer of the electronic money. There is no suggestion in Phillips to utilize the disclosed process/system with electronic cash type devices. There is no suggestion in Ito to utilize the disclosed process/system with debit (or credit) type cards. There also is no suggestion in Ito that relates to device activation. Therefore, it is submitted that it would not have been obvious to one of ordinary skill in the art to combine the teachings of these two prior art references. Rather, in light of the substantial differences as mentioned above, one of ordinary skill in the art would be discouraged and/or disinclined to combine any of their teachings.

In view of the foregoing discussion, it is respectfully submitted that the combination of Phillips and Ito for the purpose of rejecting independent claims 1, 8, 14, 18 and 24 is not proper. Even if proper, these claims are patentably distinct and unobvious over this prior art for the reasons discussed above. It is requested that the rejection of claims 1, 8, 14, 18 and 24 be withdrawn.

Claims 2-7, 9-13, 15-17, 19-23 and 25-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips in view of Ito in further view of Risafi et al. (Risafi) (US Patent 6,473,500). Applicant respectfully traverses this rejection for the reasons discussed below.

First, these claims are patentably distinct and unobvious over the combination of Phillips, Ito and Risafi since Risafi does not cure the above-mentioned deficiencies of Phillips and Ito, with respect to the previously discussed features recited in the applicant's independent claims. In particular, Risafi does not disclose providing a beneficiary with a unique device pick-up code (or fund pick-up number), presenting the code to a distributor, and activating the money pick-up device based on the pick-up code. Rather, Risafi briefly sets forth that a second card can be delivered to the transferee (col. 9, lines 51-57; also col. 19, lines 28-46). Risafi expressly provides that a card is supplied to the transferee (beneficiary) and upon providing the transferee with the PIN, the transferee is able to use the card (col. 9, lines 51-57). Therefore, Risafi, like the other cited references, fails to teach providing a beneficiary with a code (device pick-up code, fund pickup code, etc.) that is then used by the beneficiary to obtain the device (i.e., money pick-up device, ATM card) from the distributor. In both Phillips and Risafi, a card is supplied to the beneficiary without the need for the beneficiary to first supply a code (e.g., device pick-up code) to a distributor. Ito is not concerned with distribution of the disclosed IC cards. The present invention, as recited in each of the independent claims, however requires that the beneficiary supply a code to a distributor before the distributor supplies an active device to the beneficiary. Therefore, since Risafi does not cure the deficiencies of

Phillips and Ito, claims 2-7, 9-13, 15-17, 19-23 and 25-29 are patentably distinct and unobvious over the combination of Phillips, Ito and Risafi. It is therefore requested that the rejection of claims 2-7, 9-13, 15-17, 19-23 and 25-29 be withdrawn.

Arguments specific to Dependent Claims

The Examiner's specifically addresses dependent claims 2, 9, 25, 27 and 29 in the office action on page 5, lines 7-18. With respect to claims 2 and 9, it is submitted that the features recited in these claims are neither disclosed nor suggested in the cited prior art. Claims 2 and 9 recite that the "activating step includes transmitting said unique device pick-up code from said distributor to said money-transfer company, and transmitting said personal code ["pin" in claim 9] from said money-transfer company to said distributor." The Examiner asserts that Risafi discloses this feature at col. 4, line 61 to col. 5, line 10. There are at least three differences between the teachings in Risafi and the features recited in applicant's claims 2 and 9. First, the cited section in Risafi actually pertains to activation of the card upon its purchase by the customer, not during any sort of activity by a separate beneficiary. As described in greater detail in Risafi, at col. 10, lines 32-45, the card purchaser selects the pin and then the card is activated by the agent, which includes supplying the selected pin to the processing center.

Col. 10, lines 32-45 are repeated below.

"Card user 10 desires to purchase or acquire a prepaid card 100 to make purchases or withdraw cash. In step 210, card user 10 purchases a card by providing payment in cash, check, credit, or debit form to agent 104 who operates an establishment in which terminal 106 is located. Terminal 106 is connected to processing center 110. In step 220, card user 10 selects a PIN which is transmitted to card processing center 110 via terminal 106. In step 230, agent 104 begins the activation process by transmitting to processing

center 110 the card account number, PIN, and the amount of money paid by card user 10. Processing center 110 stores in an account in a database the card number, the amount paid, and the PIN, thus activating the card.” (emphasis added)

In claims 2 and 9 of the present application, the steps recited are carried out during activation, which occurs when the beneficiary supplies the device pick-up to the distributor (not when the card is purchased by the customer). Second, Risafi does not entail transmitting “another PIN from the processing center back to the distributor.” There is neither discussion nor support in Risafi for doing so. Third, in Risafi, the customer selects the PIN to be used with the card to access money. In the present application, the personal code (or PIN) is given to the beneficiary along with the activated money pick-up device (or ATM card), as recited in independent claims 1 and 8. Thus, claims 2 and 9 are further patentably distinct and unobvious over the prior art.

Claim 15 depends from claim 14 and recites the use of automatic number identification (ANI). Claim 16 depends from claim 15 and recites validation means for matching an ANI signal with a previously stored telephone number of a distributor to validate a distributor’s request to activate a money pick-up device. Claims 5, 6, 12 and 13 likewise recite these features. In the Office Action, the Examiner asserts that Risafi at col. 16, lines 11-32 discloses the features recited in Applicant’s claims 15 and 16 (Office Action, page 6, lines 3-9). Contrary to the Examiner’s assertions, this portion in Risafi does not refer to using an ANI signal and does not validate an agent’s (distributor’s) request. The referenced section in Risafi pertains to processing the purchase and activation of a telephone card, and selection of a PIN. Validation

using ANI is not disclosed in the reference. Thus, claims 15 and 16 are further patentably distinguished and unobvious over the prior art.

New claims 30-32 depend respectively from claims 1, 8 and 24. Each of these claims specifies that the activating step is carried out by selecting a money pick-up device (or ATM card) from an inventory of such devices, and then activating the selected device. Support for the recitations in claims 30-32 is set forth in the specification from page 50, line 31 to page 51, line 4. It is submitted that none of the cited references carries out the particular steps recited in claims 30-32. The allowance of new claims 30-32 is solicited.

In light of the foregoing, reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



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